

REMARKS

Claims 1 - 7 remain active in this application. Amendment of claims 1, 2, 4 and 5 has been requested to emphasize novel and unobvious functions and features of the invention. Support for the requested amendments of the claims is found throughout the application, particularly in Figures 1 and 2 and the description of these features of the invention on page 6 and elsewhere in the specification as originally filed. No new matter has been introduced into the application.

Claims 1 - 7 have again been rejected under 35 U.S.C. §103 as being unpatentable over Puram et al. This sole ground of rejection in the application is again respectfully traversed for the reasons presented in previous responses and in the response filed February 14, 2005, in particular; all of which are hereby fully incorporated by reference herein, and for the further reasons set out below.

It was previously pointed out that the present invention and the system of Puram et al. are directed to very different functions for very different purposes. The present invention is directed to facilitating communications which are complete and sufficient for transfer of information between a potential employer and a supplier of potential employees having particular skills and automating the remainder of the procurement process while Puram et al. is directed to the automated matching of employees *directly* with needs of a potential employer and *without intervention of a supplier*. To insure sufficiently complete communications for the purpose, the present invention is directed to the procurement of skilled employees through accessing the skills matching application from a Requisition/Catalog Web application and thus a more regimented and controlled

fashion more generally characteristic of procurement of commodities having different features while Puram et al. uses generalized forms and possibly artificial intelligence to make inferences about possibly required skills (see column 5, line 60, to column 6, line 31) and is principally concerned with developing scores from information entered therein to actually perform the matching which would be performed by a supplier; the intervention of which Puram et al. does not accommodate and which Puram et al. seeks to avoid. The invention, particular amended as requested above, provides for selectivity of communications with suppliers (e.g. sending notifications to "contracted suppliers" in the claims as presently rejected) whereas it is a principal function of Puram et al. to avoid suppliers and their intervention in the matching process.

In short, the present invention is directed to providing the communication of information which might be utilized by Puram et al. in performing the matching to which Puram et al. is directed to, in effect, simulate the function that might be performed by a supplier which Puram et al. seeks to avoid. By the same token, any proposed modification of Puram et al. to even colorably answer the explicit recitations of the claimed development of adequately detailed communications between a potential employer and a supplier would necessarily be improper under the precedent of *In re Gordon*, 221 USPQ 1125 (Fed. Circ., 1984) since the intended function of Puram et al. (e.g. to provide *direct* communication and matching between potential employers and potential employees would *necessarily and inherently be precluded*. Therefore, it is respectfully submitted that the Examiner cannot properly make a *prima facie* demonstration of obviousness based on Puram et al.

Further, it was previously pointed out that the

decision of the Board of Appeals and Interferences clearly pointed out a claimed element which was not taught by Puram et al. and was thus dispositive of the Appeal from a rejection for anticipation under 35 U.S.C. §102. While the Board of Appeals and Interferences left the question to the Examiner in regard to whether or not the inclusion of that element would be obvious, the decision did not indicate that any other claimed element was, in fact, found in Puram et al. Moreover, it was clearly demonstrated in the previous response that other claimed elements were not, in fact, taught or answered in the slightest degree by Puram et al. and that Puram et al. did not provide evidence of a level of ordinary skill in the art which would support a conclusion of obviousness in regard to any claim in the application. Accordingly, it was pointed out that the Examiner had not and could not make a *prima facie* demonstration of obviousness of any claim based on the teachings, suggestions or evidence of ordinary skill in the art provided by Puram et al. The Examiner has not made any specific response to any of these arguments (merely pointing out generally that the passages of Puram et al. relied upon have been indicated but which uniformly fail to answer explicit recitations of the claims which are similarly glossed over in the statement of the rejection such as, for example, the passages of columns 2 and 5 relied upon in regard to input of user/employer needs are devoid of any mention of a skills detail checklist for each of the requested technical skills) and thus continues to fail to make a *prima facie* demonstration of the obviousness of any claim.

Moreover, in an effort to even more clearly demonstrate the errors and impropriety of the Examiner's position, amendment of claims 1, 4 and 5 has been requested in order to provide a separate

"means" by which selectivity of *suppliers* is provided and which can have no counterpart in Puram et al. since suppliers and communications therewith are not accommodated and, in fact, avoided in Puram et al. Further, the claims have been clarified to indicate that it is a notification which is sent to selected suppliers and not necessarily a "request" *per se* (although in accordance with the disclosure on page 6 of the specification, the detailed request developed by the invention using the skills detail checklist may be sent as an attachment that may be retrieved and downloaded to any automated system used by the supplier and/or the supplier may directly access the Web site database to retrieve and review the detailed request developed by the invention). Neither of these forms of communication has any discernible counterpart in Puram et al. even in regard to employee communications, much less communications with suppliers.

Therefore it is clearly seen that the sole ground of rejection asserted by the Examiner is clearly in error and untenable in regard to any claim in the application as finally rejected and even more clearly in error and untenable in regard to claims amended as requested above. The Examiner continues to fail to make a *prima facie* demonstration of unpatentability of any claim based on Puram et al. and continues to attribute teachings and suggestions to passages of Puram et al. which do not, in fact, answer explicit recitations of the claims which the statement of the rejection effectively ignores. Further, the Examiner ignores the clear impropriety of the modifications of Puram et al. proposed in the statement of the rejection under the precedent of *In re Gordon, supra*, since there can be no suggestion of a modification or motivation therefor in Puram et al. when modification to answer the explicit claim recitations would

preclude the intended function thereof. Accordingly, reconsideration and withdrawal of the sole ground of rejection in this application are respectfully requested whether or not the above-requested amendments are entered.

In this latter regard, however, it is respectfully submitted that the finality of the present action is premature and should be withdrawn to permit the above-requested amendments to be entered as a matter of right. It is axiomatic that an action should not be made final when it does not contain a *prima facie* demonstration of the propriety of any ground of rejection contained therein and particularly where the preceding action failed to do so. Therefore, it is respectfully submitted that withdrawal of the finality of the present office action and entry of the above-requested amendments is clearly in order.

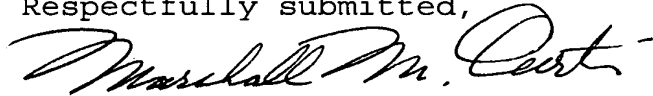
In any event, it is respectfully submitted that entry of the above-requested amendments is well - justified since the above-requested amendments are directed to emphasizing points of error previously asserted and, as such, cannot raise new issues. Entry is also well-justified as placing the application in condition for allowance or, in the alternative, better form for Appeal by materially reducing and simplifying potential issues. Accordingly entry of the amendments and consideration of the claims as so amended is respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted

that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0458 of International Business Machines Corporation (E. Fishkill).

Respectfully submitted,



Marshall M. Curtis
Reg. No. 33,138

Whitham, Curtis & Christofferson, P. C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190

(703) 787-9400
Customer Number: 30743